

REMARKS

Reconsideration of this application is respectfully requested in view of the foregoing amendment and following remarks.

By the foregoing amendments, claims 1 and 11-15 have been amended and claims 5-10 and 16 have been withdrawn from consideration. Thus, claims 1-4 and 11-15 are currently pending in the application and subject to examination.

In the Office Action mailed March 24, 2005, claims 11-15 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 11-15 have been amended responsive to this rejection. If any additional amendment is necessary to overcome this rejection, the Examiner is requested to contact the Applicant's undersigned representative.

Claims 1-4 and 11-15 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Applicant's Admitted Prior Art (hereinafter, "AAPA"), in view of U.S. Patent No. 6,175,885 to Marbot et al. (hereinafter, "Marbot"). It is noted that claims 1 and 11-15 have been amended. To the extent that the rejection remains applicable to the claims currently pending, the Applicant hereby traverses the rejection, as follows.

In order to establish a prima facie case for obviousness, three (3) criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to those of ordinary skill in the art, to modify the primary reference as proposed in the Office Action. Second, there must be a reasonable expectation of success in connection with the proposed combination of the references. And third, the prior art references must disclose or suggest all of the claim limitations. MPEP 2143. Moreover, the MPEP further states "[i]f the proposed

modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The Applicant submits that the PTO fails to satisfy its burden of establishing a prima facie case for obviousness because the Office Action fails to show sufficient suggestion or motivation to modify the AAPA by the teachings of Marbot as suggested in the outstanding Office Action. Applicant further submits that there is no reasonable expectation of success in connection with the proposed combination of the references.

Marbot is directed to a serial to parallel converter. The AAPA is directed to a parallel to serial converter. The Office Action asserts that the teachings of Marbot are germane to the AAPA "because a serial to parallel converter has an inverse function relative to a parallel to serial converter". *Office Action of March 24, 2005, at p. 4*. The Office Action concludes that for this reason, it would have been obvious to one of ordinary skill in the art to have applied Marbot's transistor arrangement teachings to the AAPA. *Id.*

Applicant respectfully submits that although a serial to parallel converter has an inverse function relative to a parallel to serial converter, the circuitry and steps necessary to implement such inverse functions do not share the inverse characteristics of the functions themselves. For example, parallel to serial conversion requires more circuitry than does its "inverse function" of serial to parallel conversion. Thus, the fact that the circuits perform operations that result in logically inverse functions does not render the circuitry necessary to implement those functions interchangeable.

Moreover, the Office Action admits that modifying the circuit of the AAPA with the transistor arrangement of Marbot “would have required a rearrangement of the clock signals” of the AAPA. *Id.* Thus, it is respectfully submitted that the proposed modification would require a substantial reconstruction and redesign of the circuit of the AAPA, as well as a change in the basic principle under which the circuit of the AAPA was designed to operate.

Since neither the AAPA nor Marbot discloses or suggests the desirability of the proposed modification, and, moreover, since the proposed modification would change the principle of operation of the AAPA, Applicant submits that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teachings of Marbot (directed to serial to parallel conversion) to the parallel to serial conversion circuit of the AAPA. Thus, Applicant submits that there is no motivation to combine the references as suggested in the outstanding Office Action.

Furthermore, assuming *arguendo* one did combine the references as suggested, one would not obtain the invention as claimed. Marbot teaches switching elements formed of a transfer gate having a p-channel type MOS transistor and an n-channel type MOS transistor. In contrast, the present invention as claimed recites:

each of said switching elements consists of a MIS transistor...

Therefore, the proposed combination fails to disclose or suggest each and every element of the invention as claimed.

For all of these reasons, Applicant submits that the combination of the AAPA and Marbot as suggested in the outstanding Office Action neither anticipates nor renders

obvious the present invention as claimed. Accordingly, withdrawal of the rejection of claims 1-4 and 11-15 under 35 U.S.C. § 103(a) is respectfully requested.

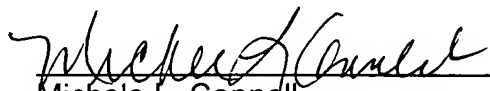
Conclusion

For all of the above reasons, it is respectfully submitted that the claims now pending patentability distinguish the present invention from the cited references. Accordingly, reconsideration and withdrawal of the outstanding rejections and an issuance of a Notice of Allowance are earnestly solicited.

Should the Examiner determine that any further action is necessary to place this application into better form, the Examiner is requested to contact the undersigned representative at the telephone number listed below.

In the event this paper is not considered to be timely filed, the Applicants hereby petition for an appropriate extension of time. The Commissioner is hereby authorized to charge any fee deficiency or credit any overpayment associated with this communication to Deposit Account No. 01-2300, referencing docket number **100021-00134**.

Respectfully submitted,
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